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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,542	01/02/2001	E-Young Wu	SIPT116812	1726

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EXAMINER

NGUYEN, HAI V

ART UNIT	PAPER NUMBER
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2142

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DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

P22

Office Action Summary	Application No.	Applicant(s)	
	09/753,542	WU, E-YOUNG	
	Examiner	Art Unit	
	Hai V. Nguyen	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the application filed on 02 January 2001.
2. Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eggleston et al.** U.S. patent no. **6,101,531** in view of **Fuisz** U.S. patent no. **6,389,455** **B1**.

5. As to claim 1, Eggleston, System For Communicating User-Selected Criteria Filter Prepared At Wireless Client To Communication Server For Filtering Data Transferred From Host to Said Wireless Client, discloses an electronic mail delivery method, comprising the steps of:

(a) creating an electronic mail, and setting parameters (*filter parameters*) of the electronic mail, including address of an intended mail recipient, via a sending computer (*Eggleston, Fig. 2, item 201; Abstract, col. 3, lines 4-39; Fig. 4, items 430, 432; col. 9, lines 26-67*);

(b) establishing a connection between the sending computer and a mail-handling server (*Eggleston, Fig. 2, item 220*), and transmitting the electronic mail and the

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parameters thereof from the sending computer to the mail-handling server (*Eggleton, Fig. 1, item 201; Abstract, col. 3, lines 4-39*);

(c) storing the electronic mail received from the sending computer in a location of the mail-handling server, and enabling the mail-handling server to transmit a mail alert message, which includes location information of the electronic mail in the mail-handling server, to the sending computer (*Eggleton, Fig. 2, item 201; Abstract, col. 3, lines 4-39; Fig. 7, items 722-730; col. 10, line 18 – col. 11, line 20*); However, Eggleton does not explicitly disclose enabling the sending computer to forward the mail alert message received from the mail-handling server to a receiving computer of the intended mail recipient. Thus, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus for implementing enabling the sending computer to forward the mail alert message received from the mail-handling server to a receiving computer of the intended mail recipient

In the same field of endeavor, Fuisz, related Method And Apparatus For Bouncing Electronic Messages, discloses, e.g., in the electronic messaging art, that *the bounce system establishes user accounts that automatically forward the user's email to the user's pre-selected forwarding email address(es). Each user creates a forwarding directory, which may comprise multiple email accounts, that the user activates and deactivates as needed (Fuisz, Fig. 2, col. 1, line 54 – col. 3, line 26).*

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Fuisz's teachings of the user's own forwarding directory used to forward the electronic mail to the intended receiving

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computer of the intended mail recipient (*Fuisz, Abstract, col. 1, line 54 – col. 3, line 26*) with the teachings of Eggleton, for the *purpose of providing the users' flexibility to create his/her own filters through the bounce system to forward emails to the intended receiving computer (Fuisz, col. 3, lines 55 – col. 4, line 5; col. 8, lines 18-36). Eggleton also suggests that the S&S listing or index is used to provide the flexibility in reviewing and requesting otherwise filtered data... Thus, a cost efficient review mechanism is provided to users for determining whether to transfer data that otherwise fails selected filter parameters (Eggleton, col. 3, lines 20-39); and*

Eggleton-Fuisz discloses, upon receipt of the mail alert message, operating the receiving computer to establish a connection with the mail-handling server, and to download the electronic mail from the mail-handling server (*Eggleton, Fig. 7, item 730; Huisz, col. 6, lines 1-8*).

6. As to claim 2, Eggleton-Fuisz discloses, enabling the mail-handling server to transmit a delivery complete message to the sending computer upon detection that the receiving computer has downloaded the electronic mail (*Eggleton, Fig. 7, item 730*).

7. As to claim 3, Eggleton-Fuisz discloses, wherein the parameters of the electronic mail set in step (a) further include a delivery time period, the method further comprising the step of: (g) enabling the mail-handling server to cancel delivery of the electronic mail to the intended mail recipient upon detection that the electronic mail has yet to be downloaded by the intended mail recipient after expiry of the delivery time period (*Eggleton, Fig.3, items 330-340*).

8. As to claim 4, Eggleton-Fuisz discloses, wherein the parameters of the electronic mail set in step (a) further include an optional self-destruct instruction, the method further comprising the step of: (h) immediately after the receiving computer has downloaded the electronic mail, enabling the mail-handling server to destroy a copy of the electronic mail stored therein upon detection that the self-destruct instruction was selected (*Eggleton, col. 12, lines 25-35; col. 13, lines 8-27*).

9. As to claim 5, Eggleton-Fuisz discloses, prior to transmitting the electronic mail from the sending computer to the mail-handling server, enabling the mail-handling server to verify user of the sending computer (*Eggleton, Fig. 3; col. 15, lines 1-28*).

10. As to claim 6, Eggleton-Fuisz discloses, the mail-handling server receives an account number and a password from the sending computer to enable the mail-handling server to verify the user of the sending computer (*Eggleton, Fig. 3; col. 15, lines 1-28*).

11. As to claim 7, Eggleton-Fuisz discloses, the mail-handling server guides the user of the sending computer through a registration procedure to generate the account number and the password for the user of the sending computer when the mail-handling server has failed to verify the user of the sending computer (*Eggleton, Fig. 3; col. 15, lines 1-28; Huisz, col. 2, line 63 – col. 3, line 26*).

12. As to claim 8, Eggleton-Fuisz discloses, prior to transmitting the electronic mail from the sending computer to the mail-handling server, operating the sending computer to encrypt the electronic mail using a validation proof obtained from the mail-handling server and issued by the mail-handling server to the intended mail recipient (*Eggleton, Fig. 3; col. 15, lines 1-65; Huisz, col. 2, line 63 – col. 3, line 26*).

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13. As to claim 9, Eggleton-Fuisz discloses, upon detection by the user of the sending computer that the intended mail recipient has yet to be issued with the validation proof, operating the sending computer to issue a request to the mail-handling server for validating the intended mail recipient, enabling the mail handling server to send validating software to the receiving computer of the intended mail recipient, and enabling the receiving computer to send a public key, which is generated upon execution of the validating software, to the mail-handling server , thereby allowing the mail-handling serves- to generate the validation proof for the intended mail recipient that is subsequently transmitted to the sending computer (*Eggleton, Fig. 3; col. 15, lines 1-65; Huisz, Fig. 5; col. 2, line 63 – col. 3, line 26*).

14. As to claim 10, Eggleton-Fuisz discloses, prior to transmitting the electronic mail from the sending computer to the mail--handling server, enabling the mail-handling server to charge mail handling fees from a monetary account of the user of the sending computer (*Eggleton, Fig. 3; col. 15, lines 1-65; Huisz, Fig. 5; col. 2, line 63 – col. 3, line 26*).

15. As to claim 11, Eggleton-Fuisz discloses, prior to enabling the receiving computer to download the electronic mail from the mail-handling server, the mail-handling server determines an operating platform used by the sending computer to create the electronic mail, detects whether the operating platform is resident in the receiving computer, and allows the receiving computer to download the operating platform when the operating platform is not resident in the receiving computer (*Eggleton, Fig. 3; col. 15, lines 1-65; Huisz, Fig. 5; col. 2, line 63 – col. 3, line 26*)..

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16. Claim 12 is corresponding system claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

17. Claims 13-19 are similar limitations of claims 2-8; therefore, they are rejected under the same rationale as in claim 2-8.

18. Claim 20 is similar limitation of claim 10; therefore, it is rejected under the same rationale as in claim 10.

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19. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 703-306-0276. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen
Examiner
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JACK B. HARVEY
SUPERVISORY PATENT EXAMINER